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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,705	10/29/2003	Emory Hutchins Matts	163.1818US01	8348
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ECOLAB INC. MAIL STOP ESC-F7, 655 LONE OAK DRIVE EAGAN, MN 55121			SMITH, KIMBERLY S	
			ART UNIT	PAPER NUMBER
			3644	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,705

Applicant(s)

MATTS ET AL.

Examiner

Kimberly S. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) 13, 15-17, 33 and 42-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 18-32 and 34-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. The Applicant's have objected to the Examiner's selection of claims for withdrawal but have not pointed out the fallacy of the claims being withdrawn. The Applicant's have stated that Species 1b specifies the combination of attractant and polystyrene. It is maintained that all claims readable upon the elected species have been examined. Applicant's are correct in noting that claims restricted to different species must be mutually exclusive and as per Paragraph 2 of the Election/restriction requirement, the Applicant's had an opportunity to traverse on the grounds that the species are not patentably distinct, and in doing so, the applicants should have submitted evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. No such evidence or statement was provided. It is noted that the election of species clearly stated that the Applicant was required to elect a single disclosed species that was inclusive of a single material, or a single combination of any disclosed material. The Applicant's elected the single disclosed species of an attractant in combination with polystyrene, as such; all claims readable upon the single disclosed species have been examined. As is customary, if a generic claim is deemed to be allowable, all species readable upon that claim will be examined. Until such time, the restriction requirement is deemed proper and is made FINAL.

2. Newly amended claims 53-61, 63-65, 67, 68, 70-73 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The

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amended claims are directed to a combination of an insect station and a mounting surface having a hole provided therein which has not previously been claimed

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 53-61, 63-65, 67, 68, 70-73 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. The inventions of the insect suppression station and the insect station system are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination claim does not require that the cover is moveable after being attached to the base. The subcombination has separate utility such as an insect suppression device to be laid upon a solid structure such as a floor.

Drawings

4. The drawings were received on 05/07/2005. These drawings are approved.

Response to Arguments

5. Applicant's arguments filed 05/07/05 have been fully considered but they are not persuasive. With regards to the 35 U.S.C. 112 rejection, it is maintained that the claims are indefinite with regards to whether an insect suppression station or a combination is being claimed. With respect to the Applicant stating that Claim 1 does not require the insect suppression device, it is noted that all claims dependent thereon also do not require the insect suppression device as it is merely stated as a functional recitation in the independent claim and thereby requires the prior art to only be capable of use with such a suppression device.

6. With regards to the Applicant's statement regarding the top housing portion 12 is not moveable in the Demarest reference, it is respectfully submitted that no such recitation is found in the Demarest reference. The Applicant has pointed to the portions 12 and 14 can be joined together by convention means such as sonic welding, radio frequency welding...or suitable adhesive. As there is no positive statement that the Demarest reference requires the two portions 12 and 14 to be non-removably joined together, the Applicant is reading limitations into the reference than are clearly disclosed. It is noted that a suitable adhesive (i.e. one that is capable of joining two portions together) can be inclusive of double-sided tape, VELCRO, liquid cement or any other known adhesive that is capable of being removed and rejoined.

7. With regards to the arguments regarding claims 11, 12 and 14, as the Applicant did not amend the claim language of the independent claim, these claims are still construed to read upon only the subcombination. As such, the cited reference only needs to be capable of being used with the claimed suppression device.

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8. With regards to the Applicant's arguments that Johnson does not provide a teaching that the underside of the lid is capable of receiving an insect suppression device, it has been held that a recitation that an element is "capable of" performing a function only requires the ability to so perform. It is maintained that the underside of lid (36) of Johnson (such as that viewed in Figure 3) is configured to contain an insect suppression device (as an insect suppression device can be inclusive of a double sided adhesive or a non-viscous adhesive gel substance).

9. With regards to the argument that Johnson does not disclose the use of a frustoconical surface extending from a back surface of the device. It is maintained that the feet as shown in the Figures define a frustoconical surface extending from the back surface of the device. In response to applicant's argument that the Johnson reference is for use with rodents where the Applicant's is intended for use with insects, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

10. With respect to the arguments regarding claim 53, as this claim is now withdrawn from consideration, the arguments are considered moot.

11. With regards to the arguments of Duston in that Duston does not describe that the device can be mounted on a surface. It is noted that Merriam-Webster's 10th Edition Collegiate Dictionary defines *mount* as "to put in position". As Duston et al. is to be put in position within

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the ground, Duston et al., meets the claim limitation of having a base that is mountable on a mounting surface (i.e. the ground). The rejections stand.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 1-12, 14, 18-32 and 34-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. Regarding claims 1-12, 14, 18-32 and 34-41, the independent claims are directed to an insect suppression station for baiting with insect suppression devices. As such, it is unclear as to whether the Applicant is claiming the suppression station or the combination of the suppression station and the suppression devices as the devices have not been positively claimed outside of a functional recitation. Claims 1-12, 14, 18-32, 34-41, 53-61, 63-65 and 67-72 have been construed for the basis of art rejection as the subcombination of the suppression station.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

16. Claims 1, 3, 29 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al., US Patent 6,807,768 (Johnson).

Johnson discloses a base (22) having a first area and a cover (24) having a second area (i.e. that located on the underside of the cover) wherein the second area is positioned to be spaced from and partially overlapping the first area and wherein the cover after attached to the base is movable.

Regarding claim 3, Johnson discloses a mounting structure (72).

Regarding claim 29, Johnson discloses an insect station having a first area (28), a cover (24) and a back side for mounting comprising a mounting structure (72), wherein the station defines a cutaway portion (74) adjacent the back surface to deflect water running down the planar surface (column 4, lines 25-26).

Regarding claim 30, Johnson discloses guide walls (64)

17. Claims 1 and 24-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Duston et al., US Patent 6,796,082 (Duston).

Duston discloses a base (2) having a first area and a cover (3) having a second area (i.e. that located on the underside of the cover) wherein the second area is positioned to be spaced from and partially overlapping the first area and wherein the cover is movable.

Regarding claim 24, Duston discloses a backside and a widest portion spaced from the back side (as can clearly be viewed in Figure 1 as the chamfer of the base).

Regarding claim 25, Duston discloses the cover is configured to be removed from the base.

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Regarding claim 26, Duston discloses the cover is deformable (inherent in the disclosure of the cover being attached via a snap-fit arrangement (column 4, line 44)).

Regarding claim 27, Duston discloses the cover comprising a rim (30) and the base comprising attachment tables (6, 7).

Regarding claim 28, as Duston discloses the cover and base are attached via a snap-fit arrangement, it is inherent that the cover must be deformed to bring the rim out of engagement with the device.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1-12, 14, 18-20, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Demarest et al., US Patent 4,841,669 (Demarest)

Demarest discloses a base that is mountable to a mounting surface, a cover, a first and second area for receiving an insect suppression device (as viewed in Figures 1 and 2), wherein the second area includes a structure configured to retain the first or second insect suppression device (reference discussion above under *Response to Arguments*) wherein the cover is attached to the base, the second area is positioned to be spaced from and at least partially overlapping the first area and wherein the cover is movable. However, Demarest does not positively disclose the means for attaching the base to the cover outside of stating they may be joined by conventional

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means such as sonic welding, solvent-bonded welding or suitable adhesive. It is noted that double-sided tape is considered to be a suitable adhesive for the adjoining of two sectional pieces (attention is drawn to Hornsby et al, US Patent 6,409,019 which shows that double-sided tape is a mechanical equivalent to other attachment means such as sonic welding, column 5, lines 17-23). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a removable adhesive such as double-sided tape, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Regarding claim 2, Demarest discloses the station enclosing the first and second areas on at least two sides (via ridges 18).

Regarding claim 3, Demarest discloses the base comprising a mounting structure to permit mounting on a planar surface (16) at an outside edge of a back surface.

Regarding claim 4, Demarest discloses guide walls (20).

Regarding claim 5, Demarest disclose the station defining two or more insect entry areas (22).

Regarding claim 6, Demarest discloses the first area including a recessed area (seen in Figure 2) for receiving the insect suppression device and tabs (26) for retaining the device.

Regarding claims 7 and 9, the vacant area defined by (18) and (20) is deemed a depression adjacent the first and second areas which facilitates the placement and removal of the suppression device.

Regarding claim 8, Demarest discloses the second area including a recessed area (seen in Figure 2) for receiving the insect suppression device and tabs (26) for retaining the device.

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Regarding claim 10, Demarest discloses the first and second areas are the same shape.

Regarding claims 11, 12 and 14, as the insect suppression device has not been structurally claimed and has been disclosed in a functional recitation, it has been held that the recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claims 18-20, Demarest discloses the station being made from any number of polymeric materials thereby being water resistant, impact resistant and plastic.

Regarding claim 25, Demarest discloses the cover being configured to be removed from the base.

Regarding claim 26, Demarest discloses the cover being deformable (as the cover is a polymeric material it is inherent that it will deform when the cover is pulled apart from the base).

20. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Demarest et al., US Patent 4,841,669 (Demarest) in view of Price et al., US Patent 6,789,352.

Demarest discloses the invention substantially as claimed. However, Demarest does not disclose the station including an outer domed portion. Price teaches within the same field of endeavor the use of an outer domed portion to help deflect water and other debris from the station. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the domed portion as taught by Price with the device disclosed by Demarest in order to help deflect water and debris which might fall onto the station.

21. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, US Patent 6,807,768 as applied to claims 1 and 3 above.

Johnson discloses the device substantially as claimed. However, Johnson only discloses a single mounting hole, not “holes”. It would have been an obvious matter of design choice to use more than one hole, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

Regarding claim 23, Johnson discloses the claimed invention except for positively stating the type of fastening means to be used. It would have been an obvious matter of design choice to use a screw or nail (as both of these means are capable of “extending through” area (72) as disclosed in Johnson) as these fastening means are notoriously well known in the art for attaching a device to a structure by extending there through.

22. Claims 29, 31, 32, 34-39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Demarest et al., US Patent 4,841,669 (Demarest) in view of Johnson et al., US Patent 6,807,768 (Johnson).

Demarest discloses a first area, a cover and a backside capable of mounting (as discussed above with regards to claims 1-3). However, Demarest does not disclose the use of a cutaway portion adjacent tot the back surface. Johnson teaches within the same field of endeavor the use of a cutaway portion (74) so as to reduce the introduction of water into the station (column 4, lines 25-26). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the cutaway portion as taught by Johnson with the device of Demarest in order to reduce the introduction of water into the station.

Regarding claim 31, Demarest as modified discloses a first recessed area for receiving a suppression device (as viewed in Figure 2) and tabs (26) for retaining the device.

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Regarding claim 32 Demarest as modified discloses a second area (as viewed in Figure 3).

Regarding claims 34 and 35, as the insect suppression device has not been structurally claimed and has been disclosed in a functional recitation, it has been held that the recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claims 36-38, Demarest as modified discloses the station being made from any number of polymeric materials thereby being water resistant, impact resistant and plastic.

Regarding claim 39, Demarest as modified discloses the invention substantially as claimed. Johnson further discloses the use of a domed portion to help direct rain and other fallen debris off of the station. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the domed structure as taught by Johnson with the device of Demarest in order to help direct rain and debris away from the station.

Regarding claim 41, Demarest as modified discloses the cover being configured to be removed if squeezed along a first axis.

23. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Demarest as modified as applied to claim 39 above, and further in view of Snell et al., US Patent 6,378,243 (Snell).

Demarest as modified discloses the invention substantially as claimed. However, Demarest as modified does not disclose the cover having an overhang portion. Snell teaches within the same field of endeavor the use of a cover having an overhanging portion so as to

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reduce ingress of excess rain or other surface water (column 21, lines 23-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the overhanging cover as taught by Snell with the device of Demarest as modified in order to reduce the amount of rain and other surface water that may enter the device.

Conclusion

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly S. Smith whose telephone number is 571-272-6909. The examiner can normally be reached on Monday thru Friday 10:00-4:00.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kimberly S Smith
Examiner
Art Unit 3644

kss



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SUPERVISORY
PRIMARY EXAMINER